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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/007,494
Filing Date: November 13, 2001
Appellant(s): GIBONEY ET AL.

Holly L. Rudnick, Esq.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 19, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-3, 5, 7, 9, 10, 12, 25-27, and 29-31.

Claims 13-24 are allowed. Reconsideration has been made to the method limitations of the claims are not taught or reasonably suggested by the prior art.

Claims 4, 6, 8, 11, and 28, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 32-33 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

The rejection of claims 1-15, 19, 20, 22, and 25-31 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together *and reasons in support thereof*. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

A substantially correct copy of appealed claims appears on page 5 of the Appendix to the appellant's brief. The minor errors are as follows: claims 4, 6, 8, 11, 13-24, and 28 are no longer under appeal, since these claims have been allowed (claims 13-24), or indicated as having allowable subject material (claims 4, 6, 8, 11, and 28), and would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 1-3, 5, 7, 9, 10, 12, 25-27, and 29-31 are the claims under appeal.

(9) Prior Art of Record

6,450,704

O'CONNOR ET AL

9-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5, 7, 9, 10, 12, 25-27, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor et al. U.S.P. No. 6,450,704, and further in view of cited prior art of Applicant (Figure 1).

O'Connor et al. U.S.P. No. 6,450,704 teaches (Fig 1; Col 3 lines 1-23) an apparatus (and method of using same) which is an encasement for a connecting device to connect and interface

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an electro-optic signal device 18 to an optical cable comprising the following: base portion 29 encasing a plurality of optical devices in an optical array, an optically transparent substrate 11 connectable to base 29, substrate 11 being optically transparent and having a glass-like structure with desired optical properties (Col 3, lines 14-16), alignment pins 28 in alignment recesses 26 on the substrate 11 to create an alignment between the connector and the communications device relative to the substrate, the alignment pins 28 attached to the base 29 by an adhesive, or formed by molding or compression fit processes (Col 4, lines 27-30).

O'Connor et al. '704 does not explicitly teach that the lid portion is adapted to have at least a portion of the optical communications device 18 there between. In Figure 1 of the prior art disclosed by Applicant, optical connector 10 connects an optical communications device 22 to an optical cable 16. A lid 12 having focusing elements 24 is affixed to the base portion 14, and the lid and base are adapted to receive at least a portion of the communications device 22 there between. Since O'Connor et al. '704 and Prior Art Fig. 1 are both from the same field of endeavor, the purpose of having the optical device 22 formed at least partially between the base 14 and lid 12 of Fig. 1 would have been recognized in the pertinent art of O'Connor et al. '704. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the connector of O'Connor et al. '704 by placing the optical device at least partially between the lid and base portion of '704, from the teaching of Fig. 1 for accurate alignment purposes.

O'Connor et al. '704 does not explicitly teach that the alignment member 28 is formed on the lid portion. The alignment member 28 is formed through the lid 11, aligning the optical device to the optical cable. The claim limitation of having the alignment member being formed

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on the lid portion does not overcome the prior art reference, since the apparatus functions as a whole, integral apparatus. Claiming separate components that function identically during use as an integral apparatus does not overcome a relevant prior art reference having the same integral functionality (see *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965)). It is an obvious modification to form the alignment members on/through any part of the apparatus, since functionality is the same, aligning the optical device to the optical cable.

Regarding claim 2, the cited prior art Fig. 1 teaches a recess to receive at least a portion of the optical communication device therebetween. Regarding claims 3, 5, 7 and 12, the alignment members of O'Connor et al. '704 are taught to be prefabricated/molded/formed (see column 4, lines 18-30) of a well-known functional material (i.e. steel/form/overlay) and applied to the substrate 11. The above rejection of claim 1 targets the obvious difference of "on" vs. "in", and since the formation of the alignment members on the lid portion has been shown to be obvious above, these dependent claim limitations are taught by the O'Connor et al. '704 reference. Regarding claim 9, the lid has a recess that receives the alignment member. Regarding claim 10, the hole in the lid is transparent and focusing portion is formed therewith.

Regarding claim 25, O'Connor '704 teaches a structure that is divisible/separable (has a plurality of different components attached together, see Fig. 1), and the devices are positioned there between the first 11 and second 29 substrates. The two parts of Fig. 1 are two different optical communication devices. Regarding claims 26, 27, and 30, the alignment members of O'Connor et al. '704 are taught to be prefabricated/molded/formed (see column 4, lines 18-30) of a well-known functional material (i.e. overlay) and applied to the substrate 11. The above rejection of claim 25 targets the obvious difference of "formed on" vs. "formed

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through", and since the formation of the alignment members on the lid portion has been shown to be obvious above, these dependent claim limitations are taught by the O'Connor et al. '704 reference. Regarding claim 29, at least two optical components exist on the 2nd substrate, as the cited prior art teaches. Regarding claim 31, the hole in the lid is transparent and at least two devices are formed therewith.

This rejection is set forth in a prior Office Action, mailed on December 15, 2003. Since some material has been indicated as being allowed (claims 13-24), or having allowable subject material (claims 4, 6, 8, 11, and 28), the rejection mailed on December 15, 2003 has been modified from its original version.

(11) Response to Argument

Appellant traverses the rejections to claims 1-3, 5, 7, 10, and 12 by stating (see page 7, lines 20-24) that the O'Connor reference contains no suggestion or motivation that alignment members can or should be formed *on* a lid portion of an enclosure, and further that the Examiner has given no suggestion or motivation to do so. Examiner disagrees with the Appellant, and that, in fact, *In re Larson 340 F.2d 965, 144 USPQ 347 (C CPA 1965)* is pertinent to the patentability of the claims at issue. The issue at hand deals with forming the alignment members on the lid portion, and if this is an obvious modification from the cited prior art in which the alignment members are formed through the lid portion. Since the optical device components (substrate, lid, alignment members) function the same, as an integral apparatus, in both the cited prior art and the claimed invention, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to form the alignment members as the same

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structurally sound apparatus. *In re Larson* teaches that securing elements to different parts (or by different means) is not a patentable distinction over the prior art. In the current case, the claimed limitations secure the alignment members to different parts of the same functional apparatus. The functionality of Appellant's independent claim 1 is to align a base to lid to a connector for an optical cable by use of alignment members. The O'Connor reference in view of the cited prior art teaches aligning a base to a lid to a connector for an optical cable by use of alignment members. *In re Larson* teaches, to a person having ordinary skill in the art, that securing these alignment members to either the base, or the lid, is not a patentable distinction. The rejections to dependent claims 2, 3, 5, 7, 10, and 12 are fully addressed in section 10 above.

Appellant traverses the rejections to dependent claims 4, 6, 8, 11, and 28 (see page 9, line 6 through page 10, line 23). The Examiner has reconsidered these claims, and agrees, that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Appellant traverses the rejection to dependent claim 9 by stating (see page 11, lines 1-14) the Examiner's rejection is not understood. The lid portion of the prior art clearly has a "recess" that receives the alignment members, and this rejection is also fully addressed in section 10 above.

Appellant traverses the rejection of claims 13-15, 19, 20, and 22 (see page 11, line 15 through page 12, line 16). These arguments are persuasive, and method claims 13-24 are currently allowed.

Appellant traverses the rejections to claims 25-27, and 29-31 by stating (see page 12, line 17 through page 13, line 16) that the that the O'Connor et al reference contains no suggestion or


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motivation that alignment members can or should be formed *on* a lid portion of an enclosure, and further that the Examiner has given no suggestion or motivation to do so. This issue (“formed on” vs. “formed through”) has been fully addressed in the first paragraph above. Further, Appellant states that the O’Connor et al reference nowhere discloses or suggests a structure that is divisible into two or more optical communication devices, each of which has at least one optical electrical device. The Examiner disagrees with this statement, since O’Connor et al. clearly shows an optical device that can be (at least initially “divisible”) in separate parts as is shown in Figure 1. Each part has optical electrical device components, either the optical cable 54, or the optical device 18. The rejections to dependent claims 26, 27, and 29-31 are also fully addressed in section 10 above.

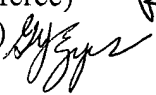
For the above reasons, it is believed that the rejections should be sustained.

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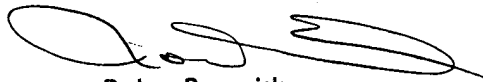
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